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Application No.: 09/778,687

Inventors: Mark James Kline *et al.*

Filed: 7 February 2001

Docket No.: 8415

Confirmation No.: 5337

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1) Second Amended Appeal Brief (15 pages)

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Amended Appeal Brief dated 24 July 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/778,687

Inventors: Mark James Kline *et al.*

Filed: 7 February 2001

Art Unit: 3761

Examiner: C. Lynne Anderson

Docket No.: 8415

Confirmation No.: 5337

Customer No.: 27752

Title: Active Change Aids for External Articles

AMENDED APPEAL BRIEF

Commissioner for Patents

Alexandria, VA 22313-1450

Real Party In Interest

The real party in interest is The Procter & Gamble Company, assignee of the entire interest.

Related Appeals And Interferences

No related appeal or interference is known to exist.

Status Of Claims

Claims 19 and 21-25 stand rejected and their rejection is the subject of this appeal. Claims 1-18, 20, and 26-36 were previously cancelled.

Status Of Amendments

No amendment was filed subsequent to the present rejection.

Summary Of Claimed Subject Matter

Independent Claim 19 is directed to a changing aid 10 (page 3, line 24 through page 4, line 6; Figures 1a, 1b, 2a, 2b, 3a, 3b, 3c, 4a, 4b)

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The changing aid comprises a mat 11 (page 5, line 2; Figures 1a, 1b, 2a, 2b, 3a, 3b, 3c, 4a, 4b) and at least one effect generating mechanism (page 2, line 28 through page 3, line 7).

The effect generating mechanism is adapted to transform at least a portion of an article 20, which is adapted to be worn externally on the body of a wearer, from a first condition to at least a second condition during the application of the article onto the body or the removal of the article from the body, and thereby assist in the application or the removal (page 4, lines 7-14; Figures 1a, 1b, 2a, 2b, 3a, 3b, 3c, 4a, 4b).

A transformation is a change in a physical property or a making of a connection between two portions of the article (page 4, lines 10-11; page 9, line 22 through page 10, line 2).

In Claim 19, the effect generating mechanism specifically changes the size, thickness, absorbency, breathability, flexibility, rigidity, elasticity, or tackiness of the portion of the article, or makes a connection between the portion of the article and another portion of the article, or activates or deactivates an adhesive.

Grounds Of Rejection To Be Reviewed On Appeal

Claims 19 and 21-25 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 5,566,398 to Deagan ("Deagan" hereinafter).

Claims 19 and 25 stand rejected under 35 USC § 102(b) as being anticipated by U.S. Patent No. 2,681,032 to Shaw ("Shaw" hereinafter).

ARGUMENT

Rejection of Claim 19 over Deagan

Please see Deagan's Figures 1-3 below for understanding of the follow description.

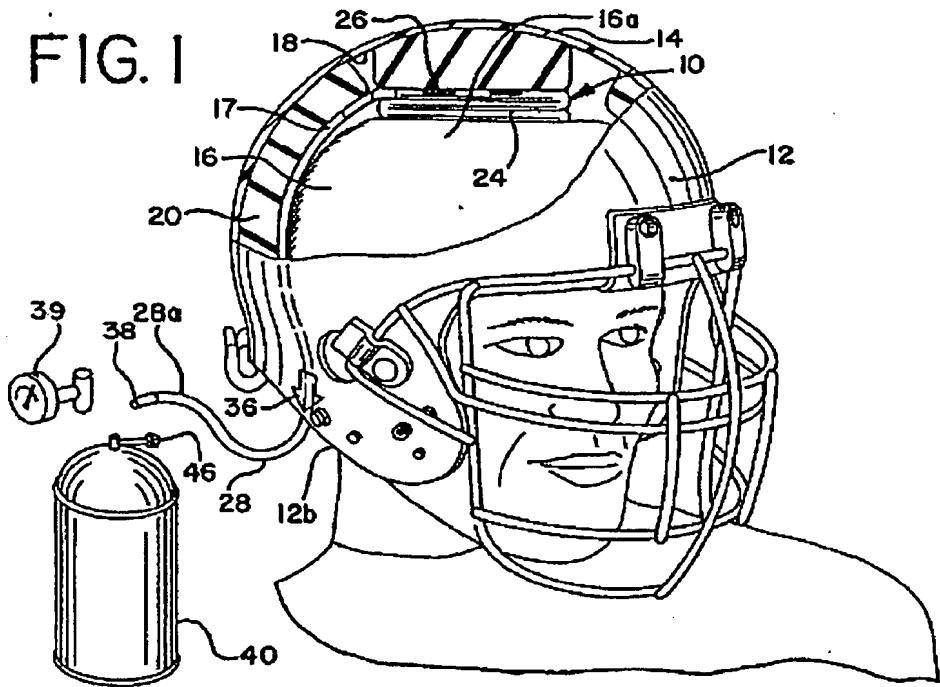
Deagan describes a known *helmet* 12, which includes a *hard outer shell* 14 and defines an *internal chamber* 17, and which "is shaped to generally fit about a head 16 of the wearer" (Deagan, column 2, lines 59-67). Padding, consisting of one more *pad(s)* 20, is removably attached to an *inner surface* 18 of the *shell* 14 by *adhesive tabs or tape* 26 "to form a snug fit

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between the helmet 12 and head 16 as is well known in the art" (Deagan, column 3, lines 1-4 and lines 53-54).

Deagan's invention is a "helmet removal device 10 [which] includes a bladder balloon 24 disposed between the helmet 12 and head 16" (Deagan, column 3, lines 11-12). A "device 40 for inflating the bladder 24...may be a canister 44 of pressurized air, a pump or other similar device" (Deagan, column 4, lines 16-20). "[T]he inflation and expansion of the bladder from the collapsed configuration, as illustrated in FIG. 1, to the expanded configuration, as illustrated in FIG. 2, at least partially displaces the head 16 from within the helmet 12" (Deagan, column 3, lines 12-18). "To retain the bladder 24 in the collapsed configuration [shown in FIG. 1] until the bladder is inflated, tacking strips 48...[shown in FIG. 3] are adhesively applied about the side edges of the folded bladder 24 so that during inflation the strips' adhesive ruptures and the strips do not interfere with the inflation" (Deagan, column 4, lines 32-39).

FIG. 1



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FIG. 2

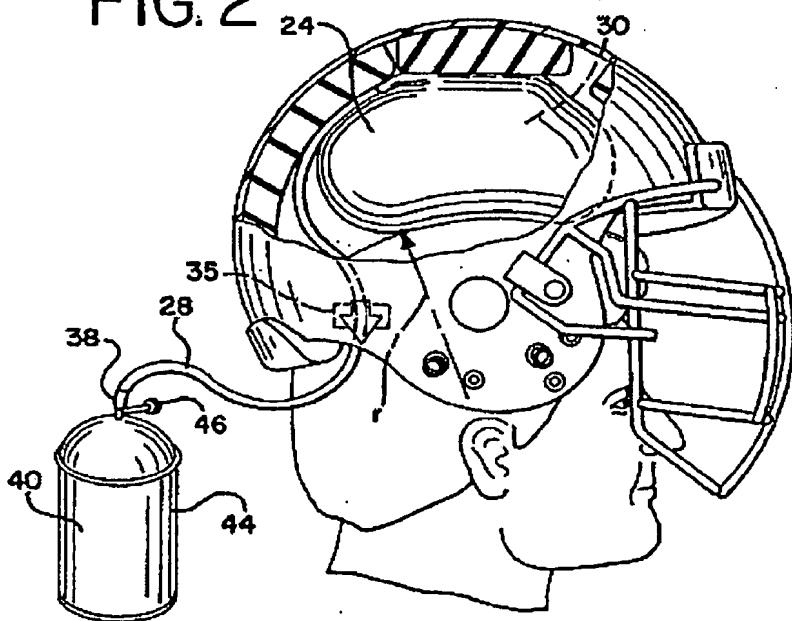
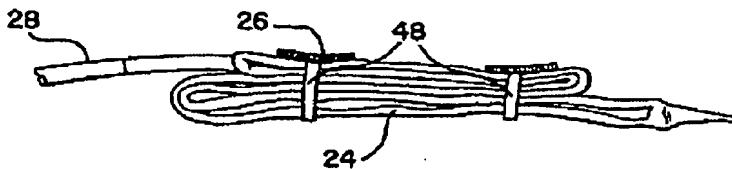


FIG. 3



In the rejection of Claim 19, Deagan's *helmet removal device* 10 was equated to the claimed *changing aid*. The *pad* 20 was equated to the claimed *mat* and the *combination* of the *inflating device* 40 and the *bladder* 24 was equated to the claimed *effect generating mechanism*. The *adhesive tabs or tape* 26 was cited as the means by which the *combination* of the *inflating device* 40 and the *bladder* 24 is joined to the *pad* 20. The *helmet* 12 was equated to the *article* that is transformed by the claimed *effect generating mechanism*. It was stated that when the *combination* of the *inflating device* 40 and the *bladder* 24 is activated, it moves the *helmet* 12, thereby *transforming* the *helmet* 12, to assist in the removal of the *helmet* 12.

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This rejection confuses and confounds the distinction between a movement and a transformation. The movement of the *helmet 12* by the *bladder 24* does not constitute a transformation of the *helmet 12*. As explicitly defined in the present Application, a **transformation** is a change in a physical property of the article or the connection or disconnection of two portions of the article (page 4, lines 10-11; page 9, line 22 through page 10, line 2). A movement is clearly distinguished from a transformation, with movements being discussed extensively beginning on page 4 at line 15 and transformations being discussed extensively beginning on page 9 at line 22. Furthermore, clear examples of both movements and transformations are provided in the present Application. Specifically, a movement is from point to point, while a transformation is from condition to condition.

In addition, Claim 19 recites specific transformations in a Markush group. These recited transformations are a change in size, a change in thickness, a change in absorbency, a change in breathability, a change in flexibility, a change in rigidity, a change in elasticity, or a change in tackiness of the portion of the article, a connection between the portion of the article and another portion of the same article, or an activation or deactivation of an adhesive. The movement of Deagan's *helmet 12* when the *bladder 24* is inflated does not equate to any of the recited transformations.

In summary, the inflation of the *bladder 24* merely moves Deagan's *helmet 12*. It does not transform the *helmet 12*. More specifically, the inflation of the *bladder 24* clearly does not cause any of the transformations recited explicitly in the Markush group.

Thus, the rejection of Claim 19 is based on an improper claim construction that confuses and confounds the fundamental distinction between moving an object, on the one hand, and transforming the object, i.e., changing a physical property of the object or connecting or disconnecting the object, on the other hand.

In addition, the rejection of Claim 19 is improper because it ignores the explicit recitation of particular transformations in the Markush group, none of which is movement and none of which is caused by the inflation of Deagan's *bladder 24*.

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Rejection of Claim 21 over Deagan

In Claim 21, the Markush group of Claim 19 is narrowed to the flexibility, the size, or the tackiness.

In the rejection of Claim 21, it was stated that “the effect generating mechanism 24, 40 [*i.e.*, the *combination* of the *inflating device* 40 and the *bladder* 24] comprises the expansion of the bladder 24 which reduces the interior size of the article [*helmet*] 12, as shown in figure 2, and therefore changes a material property of the article.” Separately, in response to arguments submitted previously, it was stated that “the size of the helmet is determined by the interior volume available for a wearer’s head. Since the bladder reduces the interior volume of the helmet by inflating and occupying the interior volume, the bladder reduces, or changes, the size of the helmet. Inflating the bladder transforms the helmet to a smaller size, which aids in the removal of the helmet from the wearer’s head.”

However, the language in the rejection and in the response to arguments confuses and confounds two fundamental concepts, namely occupying a space, on the one hand, and changing the size of the object that defines the space, on the other hand. It is fundamental that the *bladder* 24, which in combination with the *inflating device* 40 was equated to the claimed **effect generating mechanism**, is not a part of the *helmet* 12, which was equated to the claimed **article** that is transformed by the **effect generating mechanism**. Hence, although the inflation of the *bladder* 24 changes the size of the *bladder* 24 itself, it does not reduce the interior size of the *helmet* 12. Instead, the inflation of the *bladder* 24 to change its own size merely fills a portion of the *interior chamber* 17 of the *helmet* 12, without altering the size of the *interior chamber* 17 or any other portion of the *helmet* 12. In other words, the inflation of the *bladder* 24 causes the *bladder* 24 itself to expand and occupy space inside the helmet 12, but does not change the size of the *helmet* 12. Thus, the inflation of the *bladder* 24 has no more effect on the size of the *helmet* 12 than does the insertion of the wearer’s head into the same *interior chamber* 17. Specifically, neither wearing the *helmet* 12 nor inflating the *bladder* 24 inside it affects the size of the *helmet* 12. Instead, both result in merely occupying space inside the helmet 12 without changing the size of the helmet 12. An analogy is that partially filling a coffee cup does not change the size of the cup; it merely occupies some of the space inside the cup. Similarly, placing clothes inside a

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suitcase does not change the size of the suitcase; it merely occupies some of the space inside the suitcase.

In fact, there is no reasonable interpretation of the term "size" that makes it mean what is alleged in the rejection of this claim, namely that partially "filling" the *interior chamber 17* of the *helmet 12* changes the size of the *helmet 12*.

Thus, the rejection of Claim 21 is based on an improper claim construction that confuses and confounds the fundamental distinction between merely occupying a space, on the one hand, and changing the size of the object that defines the space, on the other hand.

Rejection of Claim 22 over Deagan

Claim 22 recites that the effect generating mechanism of Claim 19 is adapted to produce a thermal effect, a magnetic field, or an electric current.

In the rejection of Claim 22, it was stated that "the effect generating mechanism 24, 40 [*i.e.*, the *combination* of the *inflating device 40* and the *bladder 24*] comprises the discharge of compressed gas from canister 40, which is considered a thermal effect." However, it is not understood how the discharge of gas is a thermal effect.

Thus, this rejection appears to be based on an arbitrary equation of a discharge of compressed air with the claimed thermal effect.

Rejection of Claim 23 over Deagan

In Claim 23, the Markush group of Claim 19 is narrowed to activating or deactivating the adhesive. The claim language does not contain or somehow relate to the general notion of "adhesion". Instead, the phrase "activate or deactivate an adhesive" is recited. Clearly, the term "adhesive" is used as a noun. In particular, the term "adhesive" is used consistently throughout the present Application to refer to an adhesive substance such as glue, just as it is used ubiquitously in the art to mean. In addition, a detailed description of activatable and deactivatable **adhesives**, as well as their activation and deactivation, is provided on page 10

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beginning at line 3 of the present Application. In an example give there, a deactivatable adhesive is tacky at higher temperatures and non-tacky below a certain lower deactivation temperature.

In the rejection of Claim 23, it was stated that “the effect generating mechanism 24, 40 [*i.e.*, the *combination of the inflating device 40 and the bladder 24*] deactivates adhesive tabs 48 during the transformation”, presumably referring to the inflation of the *bladder 24*.

However, this rejection confuses and confounds the distinction between the activation or deactivation of an adhesive, on the one hand, and merely rupturing an adhesive bond, on the other hand. In fact, Deagan does not disclose anything regarding the activation or deactivation of an adhesive. Instead, Deagan’s *tacking strips 48* are “adhesively applied” around the folded *bladder 24* to retain it in its collapsed configuration until the *bladder 24* is inflated, at which time “the strips’ adhesive ruptures and the strips do not interfere with the inflation” (column 4, lines 32-40 and 59-65; Figure 3). Put another way, “[a]s air enters the bladder 24, the bladder unfolds from the collapsed configuration rupturing the connection between the tacking strips 48 and bladder 24” (column 5, lines 48-54). In other words, the force generated by the inflation of the *bladder 24* ruptures the *adhesive bond* attaching the *tacking strips 48* to the *bladder 24*.

Thus, the rejection of Claim 23 is based on an improper claim construction that confuses and confounds the distinction between activating and deactivating an adhesive, on the one hand, and merely rupturing an adhesive bond, on the other hand.

Rejection of Claim 25 over Deagan

In Claim 25, the Markush group of Claim 19 is narrowed to making the connection between the portions of the article.

In the rejection of Claim 25, it was stated that “[w]ith respect to claim 25, the claim further limits a member of the Markush group of claim 19 that is not relied upon in the rejection of claim 19, and therefore Deagan anticipates the claim.” This rejection is not understood.

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First, this rejection seemingly turns the proper examination of a dependent claim on its head. Specifically, rather than considering the additional limitation(s) of dependent Claim 25, this claim was apparently rejected *because the claim from which it depends was rejected.*

Next, Claim 25 does not, in fact, limit "a member of the Markush group of claim 19". Instead, this claim "selects" one of the members of the Markush group. As such, since the entirety of a claim must be considered, whether or not the selected member was "relied upon in the rejection of claim 19" is not determinative of whether Claim 25 itself defines patentable subject matter.

In addition, as discussed above, Claim 19 was rejected on the basis of confusion between a movement and a transformation, and apparently without consideration of the specific listing of transformations in the Markush group. These issues likewise apply to dependent Claim 25.

Finally, and most specifically, the specific transformation recited in Claim 25, of making the connection between the parts of the article, was not addressed in any way in the rejection.

Thus, the rejection of Claim 25 is based on an improper failure to consider the limitations of the claim.

Rejections of Claims 19 and 25 over Shaw

Shaw discloses a *dampness indicating accessory* for use with a diaper. In its primary embodiment, the *dampness indicator* includes a "resilient member 15 such as a rubber band", which is fixed at its upper end and attached at its lower end to a "moisture responsive, frangible means 18 which preferably takes the form of a strip of paper...the frangible means 18 normally holds the resilient member 15 under tension in a longitudinally stretched condition such that an indicator 20 formed in the face of the rubber band is out of registry with a visible reference element 21...which takes the form of an aperture...When the diaper becomes damp or wet the moisture...comes into contact with the frangible means 18 which has so low a wet strength that it is broken by the contractile force...which in turn causes the...[resilient] member [15] to contract and thus move the indicator 20 thereon into registry with the aperture 21." Shaw, column 1, line 47 through column 2, line 33.

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In the rejection, Shaw's *dampness indicating accessory* was equated to the claimed **changing aid**. In particular, Shaw's *resilient member 15 (rubber band)* was equated to the claimed **mat** and the *frangible means 18 (low wet strength paper)* was equated to the claimed **effect generating mechanism**. It was stated that “[t]he effect generating mechanism [*frangible means 18 (low wet strength paper)*] transforms a portion of the article by facilitating contraction of the mat 15 [*resilient member 15 (rubber band)*] to allow for a connection between a first portion, signal 20 [*indicator 20*], and a second portion, opening 21 [*aperture 21*]...The indication of wetness of the diaper assists in the removal process of the article.”

Before proceeding to address the rejection in detail, it is necessary to point out that nothing was identified in the rejection as corresponding to the **article** that is **transformed** by the claimed **changing aid**. As noted above, Shaw's *diaper* was mentioned in the same sentence as the term “article”. Also, separately, in response to arguments submitted previously, it was stated that “[t]he device of Shaw assists in the removal of the article by providing a signal to a user that the article needs to be removed.” Therefore, it is presumed that the *diaper* with which Shaw intends his *dampness indicating accessory* to be used is the article that “needs to be removed”.

First, and most fundamentally, the rejection confuses and confounds two distinct claim elements, namely the **changing aid**, on the one hand, and the **article** that is transformed, on the other hand. It is fundamental that the **changing aid** is not the **article** on which it acts, and *vice versa*. However, both the *indicator 20* and the *aperture 21* are parts of Shaw's *dampness indicating accessory*, which was equated to the claimed **changing aid**. Thus, the rejection is based on the relative movement of these two elements of Shaw's *dampness indicating accessory*, caused by the contraction of the *rubber band 15* of the same *dampness indicating accessory*. This contraction and relative movement of elements of the *dampness indicating accessory* have no effect whatsoever on anything external to it. More specifically, the contraction of Shaw's *resilient member 15 (rubber band)* and the relative movement of the *indicator 20* and the *aperture 21*, all elements of Shaw's *dampness indicating accessory*, do not constitute or cause a transformation of the *diaper*, as would be required in order to meet the claim limitations.

Building on the above point, both the *indicator 20* and the *aperture 21* are parts of Shaw's *dampness indicating accessory*, not the *diaper*. Therefore, whether or not a connection is made

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between Shaw's *indicator 20* and *aperture 21* is not relevant, because the claim is to a connection being made between portions of the **article** on which the **changing aid** acts, not between portions of the **changing aid** itself.

In addition, the statement that “[t]he indication of wetness of the diaper assists in the removal process of the article by providing a signal to a user that the article needs to be removed” does not relate to the claimed subject matter. Likewise, the statement that “[t]he indication of wetness of the diaper assists in the removal process of the article” does not relate to the claimed subject matter. Specifically, the claimed subject matter is not merely that the **changing aid** assists in the application or the removal of the **article** by doing anything under the sun. Instead, it is that the **changing aid** assists by transforming the article in one of the ways listed in the Markush group. Since Shaw's *dampness indicating accessory* does not do anything whatsoever to the *diaper*, but instead merely indicates wetness, then it does not assist in the removal as claimed.

This rejection also confuses two fundamental concepts, namely making a connection between two structural elements, on the one hand, and aligning two structural elements, on the other hand. In particular, the statement that “a connection [is made] between a first portion, signal 20 [*indicator 20*], and a second portion, opening 21 [*aperture 21*]” is not supported by Shaw's disclosure. As noted previously, Shaw discloses that the “*indicator 20* formed in the face of the rubber band is out of registry with a visible reference element 21...[until] the diaper becomes damp or wet...[causing the resilient] member to contract and thus move the *indicator 20* thereon into registry with the *aperture 21*.” Shaw, column 1, line 47 through column 2, line 33. In other words, the *indicator 20* is not visible through the *aperture 21* initially, but becomes visible through the *aperture 21* when moved into registry with the *aperture 21*. It is clear that no connection is made between the *indicator 20* and the *aperture 21*. Instead, they are merely brought into registry, *i.e.*, aligned with each other, so that the *indicator 20* becomes visible through the *aperture 21*. An analogy is that an automobile that is parked in front of a house does not become “connected” to the living room window merely by being visible through the window.

In the response to arguments submitted previously, it was stated that “[w]hen the resilient member of Shaw moves, a visual connection is made between the indicator and the aperture that was previously blocked by the frangible means. Therefore, the movement of the resilient

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member and the frangible means of Shaw causes a connection between the indicator and the aperture." However, this interpretation of the term "connection" is unreasonable in light of the specification and would improperly vitiate the claim. A "visual connection" is merely a mental construct that has no meaning in the present context. Shaw's *indicator 20* is visible through the *aperture 21* when the two are "in registry". There is no "connection" involved. Again, the automobile that is visible through the living room window is not "connected" to the window. Importantly, if any two portions of an article that were visible at the same time were deemed to have a "visual connection" between them, then the claim would have no meaning.

Thus, the rejections of Claims 19 and 25 over Shaw are based on an improper confusion of the claimed changing aid and the article on which the changing aid acts, an improper failure to consider the limitations of the claims, an improper confusion between making a connection between two structural elements and merely aligning them, and an unreasonable interpretation of a claim term that has the effect of vitiating the claim.

Summary

The basic requirement that the cited reference must teach every element in order to anticipate a claim has not been met with respect to any of the pending claims. Therefore, it is respectfully requested that the present rejections be reversed and that the subject Application be remanded to the Examiner with instructions for the allowance of the pending claims.

Respectfully submitted,
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Claims Appendix

19. A changing aid comprising a mat and at least one effect generating mechanism joined to the mat, the effect generating mechanism being adapted to transform at least a portion of an article adapted to be worn externally on a body of a wearer from a first condition to at least one second condition by changing a size, a thickness, an absorbency, a breathability, a flexibility, a rigidity, an elasticity, or a tackiness of the portion of the article or by making a connection between the portion of the article and another portion of the article or by activating or deactivating an adhesive during an application of the article onto the body or a removal of the article from the body to thereby assist in the application or the removal.
21. The changing aid of Claim 19 wherein the flexibility, the size, or the tackiness is changed.
22. The changing aid of Claim 19 wherein the effect generating mechanism is adapted to produce a thermal effect, a magnetic field, or an electric current.
23. The changing aid of Claim 19 wherein the effect generating mechanism is adapted to activate or deactivate the adhesive.
24. The changing aid of Claim 19 wherein the effect generating mechanism is adapted to temporarily transform the portion of the article.
25. The changing aid of Claim 19 wherein the effect generating mechanism is adapted to make the connection between the portions of the article.

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Evidence Appendix

None.

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Related Proceedings Appendix

None.